

### **REMARKS**

Claims 1-10 were pending in the present application. By this Amendment, Applicants have canceled claim 2 without prejudice to their right to present the subject matter of the claim in a future continuing application. Applicants have amended independent claim 1, and have added new claims 11 and 12, which depend from amended claim 1. Support for the claim amendment and new claims can be found throughout the specification and claims as originally filed. Specifically, support can be found, *inter alia*, at pages 2-3, and page 4, lines 12-28 in the specification. The present Amendment introduces no new matter, and thus, its entry is respectfully requested. Upon entry of the present Amendment, claims 1 and 5-12 will be pending and under examination.

### **The November 30, 2005 Office Action**

#### **Examiner's Double Patenting Rejection**

Claims 1, 2, and 5-10 were provisionally rejected on the grounds of non-statutory obviousness-type double-patenting over claims 1-6 of U.S. Pat. No. 6,855,312 (U.S. Application No. 10/030,147).

In response, Applicants respectfully point out to the Examiner that a Terminal Disclaimer was filed on October 4, 2004 with respect to the '312 patent (then U.S. Application No. 10/030,147). Accordingly, the double-patenting rejection is improper and should be withdrawn.

Examiner's Claim Rejections Under 35 USC §103

In the November 30, 2005 Office Action, claims 1, 5, and 6 were rejected under 35 U.S.C. §103(a) as being obvious over Chen (U.S. Pat. No. 6,524,626, of record) alone. Claims 2 and 7 were rejected as being obvious over Chen, in view of Gubernick (U.S. Pat. No. 6,066,327, of record) and claims 8-10 were rejected as being obvious over Chen and Gubernick, in view of Meybeck (U.S. Pat. No. 5,164,182, of record). The Examiner's rationale for the rejections is set forth at pages 3-8 of the Office Action.

As in previous Office Actions, the Examiner again has asserted that although the primary reference, Chen, discloses compositions with total antioxidant concentrations in excess of the amounts recited in the claims, lowering the concentrations to the claimed levels merely would have represented routine optimization of ranges and thus would have been obvious to one of ordinary skill in the art. The Examiner also again has taken the position that the claimed synergistic effect of the combined antioxidants simply reflects a natural flow that follows from Chen's suggested lowering of the concentrations. The Examiner has thus concluded that the cited art renders Applicants' claims obvious under 35 U.S.C. §103(a).

In response, without conceding the correctness of the Examiner's position, but to expedite allowance of the subject application, Applicants have amended independent claim 1 to recite a topical cosmetic composition for application to the skin, said composition comprising a suitable diluent or carrier in combination with a synergistic mixture of three anti-free-radical agents,

wherein the three anti-free-radical agents are selected from the group consisting of panax ginseng, morus alba, magnesium ascorbyl phosphate, sodium ascorbyl phosphate, rosmarinus officinalis and origanum vulgare, and wherein: the panax ginseng, if present, is in an amount of 0.005 to 0.1% by weight of the composition; the morus alba, if present, is in an amount of 0.0005 to 0.01% by weight of the composition; the sodium ascorbyl phosphate, if present, is in an amount from 0.05 to 2.5% by weight of the composition; the magnesium ascorbyl phosphate, if present, is in an amount from 0.05 to 2.5% by weight of the composition; the rosmarinus officinalis, if present, is in an amount of 0.01 to 0.1% by weight of the composition; and the origanum vulgare, if present, is in an amount of 0.01 to 0.1% by weight of the composition. Accordingly, in the claims as amended, the synergistic mixture according to the present invention is now directed to a mixture of three anti-free-radical agents selected from a group of only six anti-free-radical agents, i.e. panax ginseng, morus alba, sodium ascorbyl phosphate, magnesium ascorbyl phosphate, rosmarinus officinalis and origanum vulgare. In addition, weights of each of the six recited anti-free radical agents are also recited in the claims.

The selection of three anti-free radical agents from the group of six now specified in claim 1 is not suggested by nor derivable from the Chen reference. In addition to Applicants' prior comments with respect to the Chen reference, Applicants provide the following remarks. Chen relates to skincare compositions containing 3-68.3% w/w ginseng. Some of the illustrative examples also contain morus alba, but other than its inclusion in the examples, there is no other

disclosure regarding this ingredient. Furthermore, Chen does not disclose any one of sodium ascorbyl phosphate, magnesium ascorbyl phosphate, rosmarinus officinalis or origanum vulgare. Applicants note that the Examiner has particularly highlighted the Chen Examples as providing the pertinent disclosure, especially Example 22, which requires a mixture of ginseng, grape seed extract and ascorbic acid. Applicants point out that neither grape seed extract nor ascorbic acid is recited in amended claim 1.

Similarly, the remaining Chen examples do not suggest any of the 3 part combinations of claim 1. Out of the 9 Chen examples particularly highlighted by the Examiner, Examples 4, 6, 14, 20, and 27 disclose compositions containing only 2 of the 6 particular anti-free radical agents now specified in amended claim 1 and Examples 9, 13, and 26 disclose compositions containing only 1 of the 6 particular anti-free radical agents now specified in amended claim 1. Thus, the skilled artisan would not arrive at any of the synergistic mixtures of claim 1 from the teachings of the Chen reference.

Applicants further note that the distinction between the Chen reference and the present invention is not only seen in the different selection of ingredients, but also in the different amounts of the ginseng and morus alba present in the Chen formulations. For example, Ginseng is disclosed to be present in amounts between 3% (Examples 19, 23) and 68.3% (Example 14), and the morus alba is disclosed to be present in an amount of 1% of the composition in each of the Examples in which it is contained. This contrasts with the amounts of these ingredients

recited in present claim 1, relating to anti-free-radical agents that require these ingredients to be present in amounts of 0.005 to 0.1% and 0.0005 to 0.01% by weight of the composition, respectively.

Applicants also note the Examiner's position that a difference in concentration will not support patentability unless evidence is supplied to show that the concentration of the ingredients is critical. However, Applicants wish to draw the Examiner's attention to the fact that the much greater amounts of the ginseng and morus alba mentioned in Chen indicate that these ingredients are contained in the Chen formulations for a different purpose, namely to deliver fresh vitamins and other nutrients to the skin. Thus, the use of relatively large amounts, i.e. 1% for morus alba, at least 1% for each of the other herb and plant products, and in the case of ginseng, considerably more (i.e. 3% up to 68.3%) is necessary to provide a therapeutic effect to improve the appearance of the skin on topical application of the composition.

Accordingly, the skilled artisan would not consider substituting the nutrient extracts of Chen into the skin care compositions of the present invention in the amounts recited in claim 1, which amounts now have been shown to protect the skin effectively from free radicals (see page 3 lines 5-7 of the specification). There simply is no motivation and no suggestion to be found in the Chen reference that would lead to the particular selection of ingredients in claim 1 in the amounts specified.

Applicants also note the following statement by the Examiner (page 4 of the Office Action):

“The reference teaches that ‘one gram of ginseng berry contains 1.4 times more anti-oxidant than [sic] 10mg of Vitamin C’. Thus it would have been obvious to a skilled artisan that even smaller amount of ginseng extracts than exemplified in reference would still provide stronger antioxidative effects than 1% of vitamin C which is present in the Example.”

Applicants do not agree with the Examiner’s interpretation of and conclusions to be drawn from the statement shown in internal quotation marks. This statement discloses to the skilled artisan that 1000mg ginseng berry contains 1.4 times more anti-oxidant than 10mg of Vitamin C. Thus, 10mg ginseng berry contains  $1.4/100$  (i.e. 0.14) anti-oxidant compared to 10mg of Vitamin C. Therefore, the skilled artisan would understand that ginseng berry has a much lower antioxidative effect than vitamin C, in fact, nearly 1/70th the antioxidative effect of Vitamin C. Accordingly, the 1% vitamin C in the Chen reference would have to be replaced by over 70% ginseng to achieve the same effect. Thus, this disclosure cannot reasonably be considered to lead the skilled artisan to a composition containing ginseng at a maximum amount of 0.1% w/w of the composition as recited in the claims. Rather, the Chen disclosure teaches that larger amounts of ginseng should be incorporated in compositions if such compositions are to be effective. For at least these reasons, Chen does not render obvious any of the present claims. Accordingly,

Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection of the claims over Chen.

With respect to the rejection of claims 2 (now canceled) and 7 over Chen in view of Gubernick, Applicants refer to and reiterate the remarks set forth above, as well as the previous remarks made in connection with the Gubernick and Chen references. Furthermore, as mentioned previously, Gubernick teaches that in order to be effective in preventing and treating the signs of photoaging, a mixture of at least 5 ingredients is required. Thus, the Gubernick compositions comprise a mixture of a) tocopherol and derivatives (generally in the range 0.01-20%), b) ascorbic acid and derivatives (generally in the range 0.01-20%) , c) butylated phenol (generally in the range 0.01-1%), d) a rosemary extract (generally in the range 0.0001-1% ) and e) ubiquinone or derivatives (generally in the range 0.01-1%). There is no suggestion or motivation that can be derived from this disclosure that would lead one to arrive at the group of 6 anti-oxidants from which 3 may be selected to provide a synergistic mixture as recited in amended claim 1 of the present application. Moreover, there is also no motivation for the ordinarily skilled artisan to combine a) ginseng and morus alba from the nutrient Chen compositions with b) magnesium ascorbyl phosphate and rosemary from the 5 part Gubernick compositions and c) origanum vulgare and sodium ascorbyl phosphate in a topical composition. Therefore, a combination of Chen and Gubernick does not render obvious any of Applicants' present claims. Accordingly, Applicants

respectfully request reconsideration and withdrawal of the Examiner's rejection of claims 2 and 7 based on a combination of Chen and Gubernick.

With respect to the Examiner's rejection of claims 8-10 over Chen, in view of Gubernick and Maybeck, Applicants refer to and reiterate the comments made previously and above in connection with these references. In particular, Applicants point out that Maybeck is based on the finding of a synergistic effect when an extract of mulberry, preferably *morus alba*, is incorporated into hydrated lipidic lamellar phases or liposomes. This particular use yields an enhanced activity for the extract and has been found to be particularly effective in compositions to provide skin lightening or anti-inflammatory activity. In this synergistic combination, the only necessity is inclusion of 0.005-1 % mulberry extract. There is simply no suggestion or motivation from the Maybeck disclosure to lead a person skilled in the art to the synergistic 3-part composition now recited in the claims of the present application. The lack of motivation to combine Chen and Gubernick has been described above. In light of the above, one also would not have been motivated to combine the teachings of Maybeck with those of either Chen or Gubernick. Therefore, no combination of Chen, Gubernick, or Maybeck renders obvious any of Applicants' present claims.

Accordingly, in light of the above remarks, and in view of the amended claims, Applicants respectfully request reconsideration and withdrawal of all of the rejections set forth by the Examiner under 35 U.S.C. §103.



Applicants believe that the Examiner's rejections set forth in the November 30, 2005 Office Action have been fully overcome by the remarks and claim amendments presented herein, and that the present application is in condition for allowance. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Skacel', written over a horizontal line.

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